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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,637	03/21/2001	Anthony Cornelis de Visser	VER-142XX	3042

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WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP
TEN POST OFFICE SQUARE
BOSTON, MA 02109

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,637

Applicant(s)

DE VISSER ET AL.

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-12 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,9-12 and 19 is/are rejected.
- 7) ☒ Claim(s) 5,6 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Applicant's response filed on 07/09/2004 has been fully considered. The 35 USC 103(a) rejection over Kuwabara et al. (EP 0 649 753 A1) has been withdrawn in view of Applicant's amendment to claim 1.

2. Claims 1 and 8 are amended; claims 7, 13-18, 20 and 21 are cancelled; and thus claims 1-6, 8-12 and 19 are pending.

Claim Rejections - 35 USC § 103

3. Claims 1-4, 9-12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (US 5,672,413).

Taylor discloses a transfer an ink jet transfer system comprising a temporary carrier sheet, a protective layer on the carrier sheet and an image receptive adhesive layer on the protective layer (abstract). The adhesive layer is equivalent to the claimed release or barrier layer. The adhesive layer comprises polymeric resins and 0-10% spacer particles (col. 4, lines 5-9). The adhesive layer accepts hot melt ink (col. 3, line 59). With respect to porosity value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Taylor reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that

the subject matter shown to be in the prior art does not possess the characteristic relied on.

Taylor does not disclose the ink receiving layer is being applied on to a certain side, i.e., wire side of the paper base. It is known that the wire side of a paper is smoother, and it is also known that applying a coating composition onto a smoother surface improves surface contact between the paper and the coated layer. Therefore, at the time of the invention, a person of ordinary skill in the art would have been motivated to select the smoother side of a paper in order to increase surface contact.

With respect to claim 11, since the transfer system of Taylor is substantially identical to the claimed invention, the transfer system of would have a photo quality as the claimed article.

With respect to claims 9 and 19, Taylor does not disclose a non-transferable dye in the liquid reactive resin layer. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to add the dye in the layer to change the color of the layer as desired.

Response to Arguments

4. Applicant's argument is based on that unlike the claimed release or barrier layer, the prior art's adhesive layer is designed to be transferred to a target material. This argument is not persuasive because the Applicant fails to expressly recite that the claimed release or barrier layer is not designed to be transferred.

The Applicant also argued that the claimed invention does not require a special layer between the base paper and the release or barrier layer, and also that the claimed base paper does not require a special treatment. These arguments are not persuasive because the claimed invention does not **exclude** the addition of a layer between the base paper and the release or barrier layer, and the claimed invention is limited to untreated base paper only.

The Applicant further argued that the claimed release or barrier layer is not an adhesive layer and the silica in the adhesive layer does not improve the transfer properties of the transfer paper. The argument has not been found persuasive because it has been shown in the previous Office Action (see also paragraph 3, above) that the adhesive layer of the prior art and the claimed release or barrier layer are made of substantially identical materials, thus the adhesive layer and the release or barrier layer function in the same manner.

For the above reasons claims 1-4, 9-12 and 19 stand rejected.

Allowable Subject Matter

5. Claims 5, 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Betelhem Shewareged
September 27, 2004.